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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/517,599

09/14/2005

Taketo Hayashi

4367-0106PUS1

9134

2292 7590 02/06/2008
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EXAMINER

BERCH, MARK L

ART UNIT

PAPER NUMBER

1624

NOTIFICATION DATE

DELIVERY MODE

02/06/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/517,599	Applicant(s) HAYASHI ET AL.	
	Examiner /Mark L. Berch/	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 22-29 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,8-20 and 22-29 is/are rejected.
- 7) ☒ Claim(s) 4 and 7 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/13/2004, 04/28/2005</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 5 is rejected under 35 U.S.C. 102(b) as being anticipated by Brathe.

See compounds 5a, 5c and 5d.

Claims 5 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Hocek (1560-1578) or Hocek 1055.

In Hocek (1560-1578), see 1a-1c, 6a-6c, 8a-8c. The conversion of 1 to 6 meets claim 14, as TBAF is a base. Hocek 1055 has a similar teaching. See chart 1.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 488366.

See the dozens of species in tables 1A and 1B. Claim 2 is anticipated by the intermediates see e.g. page 25, lines 32-34.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Abiru.

See compounds 9, 10 in Table 1.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Volpini.

See species in Schemes 1, 2 and 3, e.g. compound 11.

Claims 1, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Bakkestuen.

Table 2, entries 3,4,5 anticipate claim 5. Entries 38 and 36, and Table 4 entry 4 anticipate claim 1.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Matsuda.

See compounds 23, 22, 14 and 9.

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Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Camaioni.

Note compounds 10c, 10d.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by LEGRAVEREND.

See compounds of type 2 in Table 1.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Mager.

See Table 1 and Figure 1.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Nair.

See the compound prepared in the scheme.

Claim 1, 10, 24-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Adah 1997.

The compounds of type 7 and 8 anticipate claim 1. The step called vii anticipates claim 10, as TEA is a base. Note Table 1, item 4 for A as an aryl group.

Claim 1, 10, 24-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Cristalli.

Note compounds 4 and 5-35. For the process claims, see Scheme 1, method B, along with its description on pages 1467, using a base, CuI, and a Pd-phosphine catalyst.

Many other references could be cited.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-3, 5-6, 8-20, 22-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The references to an amino protecting group in X1 and Z1 are not clear. These are final products. The correct selection of a protecting group requires some knowledge of what is being protected against.

Claims 13 and 15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Such a process cannot possibly be considered enabled as written. This would read on using compounds such as aniline or sodium acetate. Such reagents simply will not work.

Claim Objections

Claims 4 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Mark L. Berch/ whose telephone number is 571-272-0663. The examiner can normally be reached on M-F 7:15 - 3:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on (571)272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Mark L. Berch/
Primary Examiner
Art Unit 1624**

2/4/2008